UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,546	06/04/2001	Geoff J. Clark	NIH-05080	7592

23535 7590 02/24/2004

MEDLEN & CARROLL, LLP
101 HOWARD STREET
SUITE 350
SAN FRANCISCO, CA 94105

EXAMINER	
SCHNIZER, RICHARD A	

ART UNIT	PAPER NUMBER
1635	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/873,546	CLARK ET AL.	
	Examiner	Art Unit	
	Richard Schnizer, Ph. D	1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☒ The proposed amendment(s) will not be entered because:

(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: *See Continuation Sheet*.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☐ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1-4,6-16 and 29*.

Claim(s) withdrawn from consideration: _____.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Continuation of 2. NOTE: New claim 35 recites "the derivative" without antecedent basis, and also lacks adequate written description an enablement because the specification fails to describe or teach how to make the genus of polypeptides that are not identical to SEQ ID NO:5 but which have the functional characteristics required by the claim. Amendments to claims 6 and 11 render the method steps nonconcordant with the preamble, i.e. the preamble limits claims to methods of detecting or amplifying a nucleic acid encoding the protein of SEQ ID NO:5, but the concluding method step is not limited to detecting or amplifying nucleic acids encoding SEQ ID NO:5 because it requires only detection or amplification of a 'nucleic acid encoding Rig'.

Continuation of 5. does NOT place the application in condition for allowance because:

Amendment to add a verb to claim 3 would have overcome the indefiniteness rejection, had the amendment been entered. Applicant argues that a verb was added in the response mailed 7/25/03. Applicant's attention is directed to page 3 of that submission, in which claim 3 clearly lacks a verb.

Applicant's proposed amendment to claims 6 and 11 would have overcome the indefinitness rejection. However, this amendment would not overcome the enablement and written description rejections for the reasons of record because the claims continue to embrace methods of detecting 'a nucleic acid encoding Rig'. Although the preambles recite methods of identifying or amplifying a nucleic acid encoding the protein of SEQ ID NO:5, the concluding method steps are broader than this and embrace detection or amplification of any nucleic acid encoding 'Rig'. This breadth is not enabled or described for the reasons of record.

Applicants arguments regarding the rejections under 35 USC 102 and 103 citing Lamerdin are unpersuasive because they are based on the contention that Lamerdin does not teach a vector consisting essentially of an open reading frame linked to one or more regulatory elements, wherein the open reading frame encodes SEQ ID NO:5. Lamerdin teaches a bacterial artificial chromosome comprising an open reading frame encoding the polypeptide of SEQ ID NO:5. Lamerdin explicitly identifies the coding sequence at bases 722410-73006 as a coding sequence, and notes that the coding sequence encodes a polypeptide that is similar to Ras-related proteins. Lamerdin then provides a translation of the coding sequence that is identical to SEQ ID NO:5. Applicant has failed to provide any evidence or reasoning to show that any sequence in the bacterial artificial chromosome of Lamerdin would materially affect the basic and novel characteristics o the nucleic acid sequence encoding SEQ ID NO:5. Applicant only indicates that these sequences do affect the basic and novel characteristics of the nucleic acid sequence encoding SEQ ID NO:5, but fails to say how. For example, Applicant has not shown that the vector of Lamerdin will not function as an expression vector for SEQ ID NO:5.

Applicant argues that the obviousness rejections of claims 6 and 11 and dependents read on SEQ ID NO:4 which is not taught by the cited references. In response the PTO notes that these claims also read on nucleic acids having complementarity to at least a portion of SEQ ID NO:4, so that there is no requirement that the netirety of SEQ ID NO:4 must be taught by the cited references. Applicant has failed to show that the cited art does not teach nucleac acids with complementarity to a portion of SEQ ID NO:4.

Applicant argues at page 13, second full paragraph that there is no need to consider the obviousness rejection of claim 2, based on the art-recognized equivalence of degenerate codons encoding the same amino acid, because claim 2 does not read on any particular nucleotide sequence. Applicant's attention is directed to claim 2 which limits the claimed nucleotide sequence to SEQ ID NO:4. Applican has still failed to respond to the issue of whether or not it would have been obvious to substitute a CAA codon for a CAG codon.

At pages 13 and 14 of the response Applicant argues regarding the rejections of claims 6-16 and 29 that none of the cited art teaches SEQ ID NO:5. Applicant's attention is directed to Lamerdin, which teaches a nucleic acid encoding SEQ ID NO:5, thereby removing the basis of Applicant's argument.

Applicant argues that Yu fails to anticipate claims 6-15 and 29 because the specification teaches that a Rig protein has the amino acid sequence of SEQ ID NO:5, and Yu does not teach detection of SEQ ID NO:5. This is unpresuasive because the specification does not limit the definition of a Rig protein to SEQ ID NO:5, and clearly intends to embrace proteins other than SEQ ID NO:5 while not setting any clear limits as to what is not embraced by the term Rig. Further, Yu teaches the same method steps as the claimed invention, i .e. providing a sample comprising a nucleic acid encoding Rig; providing a nucleic acid probe or primers with complementarity to at least a portion of SEQ ID NO:4 or its complement; performing hybridization or amplification; and detecting the products. Because the proposed amendments do not limit the identified nucleic acid to one that encodes SEQ ID NO:5, Yu would still anticipate the claims if the amendment had been entered.

DAVE T. NGUYEN
PRIMARY EXAMINER